

**REMARKS**

Claim Status

The claims in consideration are claims 1-28. The independent claims are 1, 6, 12, 18, 26, 27, and 28. Claims 25-28 have been added by this amendment.

Interview and Interview Summary

Applicant appreciates the courteous telephone interview granted to Applicant and his representative on May 13, 2004 at which time the previously pending claims were discussed. Applicant appreciates the Examiner's indication that the method claims 6-24 appear to be allowable over the prior art of record. Applicant further appreciates that the Examiner agreed to create the written record of the interview.

New method claim 26 parallels method claim 6, but changes fifty-two cards to a plurality of cards. New method claim 27 parallels method claim 12, but changes fifty-two cards to a plurality of cards. New apparatus claim 28 parallels method claim 6.

With regard to the Interview Summary received by the Applicant's representative by facsimile on June 7, 2004, the Examiner states that the "method claims may have allowable subject matter, however, it is not clearly recited. The method claims should include steps reciting examples of what happens when two wild cards are flipped, what happens if two non-scoring cards are flipped, what happens if 1 rock card, 1 paper card, 1 scissor card are flipped."

The Examiner is referred to all of the method claims (i.e., claims 6, 12, 18, and 27. The method claims contain the following limitations "wherein a hierarchy of cards provides that the paper card wins over the rock card, the scissors card wins over the paper card, the rock card wins over the scissors card, the non-scoring cards lose to all other cards, any one of the non-scoring cards does not win over another of the non-scoring cards, the wild cards win over all other cards, and any one of the wild cards does not win over another of the wild cards." (Emphasis added).

Allowance of the method claims is respectfully requested.

With regard to the Examiner's statements with regard to the apparatus claim, the Applicant has provided case law throughout this paper supporting the conclusion that printed matter should be

given patentable weight. In this case as explained in detail hereinafter, the printed matter is functionally related in a new or nonobvious way to the cards upon which it is placed. Reconsideration is respectfully requested.

Claim Rejections - 35 U.S.C. §102

Claim 1 is rejected under 35 U.S.C. §102(e) as being anticipated by United States Patent No. 6,598,880 to Addabbo (hereinafter "Addabbo").

The Examiner states that: "The only difference between the visual representation on Addabbo's cards . . . and the visual representations in claim 1 of the present invention resides in the meaning and information conveyed by **printed matter**. Such differences are considered unpatentable." (citing, **Ex parte Breslow**, 192 U.S.P.Q. 431) (Emphasis not added). Applicant respectfully traverses this rejection.

It is important to point out that the printed matter, in this case, is functionally related in a new or nonobvious way to the cards upon which it is placed. The visual representations claimed by the Applicant are educational in that the player is required to discern the hierarchy by the visual representation on the cards.

For example, the player will need to recognize that the broken scissors are broken, hence, they are at a lower tier on the hierarchy and not capable of winning over, for example, a little brother card. The printed matter distinguishes the invention from the prior art in terms of patentability in this case.

The visual representations or design elements on the cards in the present invention function to indicate a hierarchy and to determine the outcome of the hand. Specifically, there are three levels of hierarchy (i.e., wild cards, scoring cards, and non-scoring cards). The visual representations or design elements are more than an arrangement of printed matter on cards.

There is a definite and decided relationship between the cards and the printed matter, and the printed matter serves a critical feature of the cards or more specifically determines the winner of a card game according to the present invention. The one depends upon the other. In other words, there is a cooperative relationship between the printed indicia and the cards in the present invention, without which it would be impossible for a game of cards to have a winner because it would fail to function in its intended manner.

The present case is similar to *Flood v. Coe*, 31 F. Supp. 348,

45 USPQ 72 (D.D.C. 1940). *Flood v. Coe* involved a new price ticket for tagging garments in retail stores. It was common to use tickets with duplicate sets of information on the top and bottom parts of the ticket with a perforation in between parts. Upon the sale, the bottom portion could be torn off and retained by the store. The new ticket, however, arranged the two sets of information along each side of a lengthwise perforation with the price at the bottom. The advantage was that "when divided along another straight line extending perpendicular to the line of perforation both price marks may be severed and new price marks may be printed in the space left for that purpose, without removing the ticket from the garment and without interfering with the other indicia on the two sections." *Id.* at 349. The United States Patent and Trademark Office rejected Flood's application stating the invention involved unpatentable printed matter. In holding that Flood's invention was patentable over the art cited, the court stated:

It is only by the *novel shape* of the ticket, the disposition of the weakened line lengthwise of the sections, and the ***unique relationship of the indicia to the structural features*** that the ticket can be re-marked by severing the ticket along another line transversely of the first. *Id.* (Emphasis added.)

Similarly, *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969) involved a measuring device designed to enable cooks to prepare fractional recipes without having to compute and measure out such quantities as  $1/3$  of  $2/3$  cup. Miller's invention consisted of proportionally-scaled measuring cups and spoons. For example, a measuring cup may be designated "one-half recipe" and then be calibrated in the normal fashion of  $1/4$  cup,  $1/3$  cup, 1 cup, etc. A cook could then follow the recipe numbers literally and yet prepare a one-half recipe. The United States Patent and Trademark Office rejected the claims as unpatentable stating that the invention involved unpatentable printed matter. The court reversed and held:

As for the examiner's characterization of the indicia and legend as "unpatentable printed matter," we note that the examiner himself recognizes the fact that printed matter, in an article of manufacture claim, can be given "patentable weight." ... His characterization of printed matter as "unpatentable" is beside the point; no attempt is here being made to patent printed matter as such. **The fact that printed matter by itself is not patentable subject matter, because non-statutory, is no reason for ignoring it when the claim is directed to a combination.** Here there is a new and unobvious *functional relationship* between a measuring receptacle, volumetric indicia thereon indicating volume in a certain ratio to actual volume, and a legend indicating the ratio, and in our judgment the appealed claims properly define this relationship. *Id.* at 1396. (Emphasis added).

Accordingly, Applicant respectfully submits that the claims are directed to three groups of cards including wild cards having a little sister or brother visual representation thereon, scoring cards having a rock, paper, or scissors visual representation thereon, and non-scoring cards having a broken rock, crumpled paper, or broken scissors visual representation thereon. Therefore, the present invention is directed to a new and non-obvious combination and not the printed matter alone, per se, and thus should be given patentable weight as a functional relationship between the playing cards AND the visual indicia claimed on the cards.

Further, Applicant claims in claim 1, for example, a "deck of . . . cards, comprising: fifty-two cards, wherein the fifty-two cards include three groups of cards, the three groups of the fifty-two cards comprising: a plurality of wild cards . . . a plurality of scoring cards . . . [and] a plurality of non-scoring cards . . . and wherein all of these groups of cards have point values thereon . . . " (claim 1).

Addabbo does not teach or disclose a deck of cards or a method of playing cards that includes wild cards, scoring cards, and non-scoring cards, all having point values thereon, as claimed

by the Applicant.

A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently, described in a single prior art reference. The identical invention must be shown in as complete detail as contained in the claim. The elements must be arranged as required by the claim. (M.P.E.P. § 2131). Nowhere in Addabbo does it disclose, *inter alia*, a deck of . . . cards, comprising: fifty-two cards, wherein the fifty-two cards include three groups of cards, the three groups of the fifty-two cards comprising: a plurality of wild cards having a little sister or brother visual representation thereon, a plurality of scoring cards having a rock, paper, or scissors visual representation thereon, and a plurality of non-scoring cards having a broken rock, crumpled paper, or broken scissors visual representation thereon, and wherein all of these groups of cards have point values thereon. Addabbo does not describe or teach the Applicant's claimed invention.

Accordingly, reconsideration is respectfully requested, and a notice of allowance is respectfully solicited.



Claim Rejections - 35 U.S.C. §102

Claims 6-24 are rejected under 35 U.S.C. §102(b) as being anticipated by the card game "War." The independent claims involved in this rejection are claims 6, 12, 18.

Claims 6, 12, 18 are method claims that claim methods of playing cards with a plurality of players using a deck of cards comprising fifty-two cards, wherein the fifty-two cards include a plurality of wild cards, a plurality of scoring cards, and a plurality of non-scoring cards, and wherein all of the three groups of cards have point values thereon.

The card game called "War" is not played with wild cards, scoring cards, and non-scoring cards. Rather, War is played with the standard deck of cards. The Jacks have a point value of eleven, queens have a point value of twelve, Kings have a point value of thirteen, and Aces have a point value of fourteen.

To play War, the cards are shuffled and dealt face side down. Each player reveals his or her top card to each other and whichever player has the higher card value wins the hand and takes the loser's card. The winner's pile thus increases by one while the loser's pile decreases by one. The winner reveals his or her next card first. The game continues this way until someone has

all fifty-two cards, unless WAR! occurs.

WAR! occurs when two players reveal their cards to be both the same value cards (e.g., Ace and Ace). When this happens, each player deals three cards from his or her pile face side down and a fourth card face side up. The fourth cards are then compared to see which card has the higher value. Whoever has the higher value card wins the WAR! and to the winner goes the spoils. If the fourth cards have the same value, WAR! is declared again until a winner is determined.

A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently, described in a single prior art reference. The identical invention must be shown in as complete detail as contained in the claim. The elements must be arranged as required by the claim. (M.P.E.P. § 2131). The game of War is not played in the same way or with the same cards as the Applicant's claimed invention and, hence, does not describe or teach the Applicant's claimed invention.

Accordingly, reconsideration is respectfully requested, and a notice of allowance is respectfully solicited.

Claim Rejections - 35 U.S.C. §103

Claims 2-5 are rejected under 35 U.S.C. §103(a) as being unpatentable over Addabbo. Further, claims 6-24 are rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, 35 U.S.C. §103(a) as being obvious over War. Note: The response to the 35 U.S.C. §102(b) rejection is set forth above.

The arguments with respect to claim 1 above apply to claims 2-5 because claims 2-5 depend, directly or indirectly, from claim 1, and these arguments are hereby incorporated by reference.

The arguments with respect to claims 6, 12, and 18 above apply to claims 7-11, 13-15, and 19-24 because these claims depend, directly or indirectly, from claims 6, 12, and 18, and these arguments are hereby incorporated by reference. The game of War does not disclose, teach, or make obvious the Applicant's claimed three groups of cards including wild cards, scoring cards, and non-scoring cards.

In this case, the Examiner states that the point values on the cards are not given any patentable weight. Thereafter, the Examiner states that in "game apparatus claims, only the claimed elements having physical structure, (e.g., fifty-two cards, three

groups of cards, etc.) are given patentable weight." (Office Action, dated March 5, 2004, Page 3). Applicant respectfully points out that the three groups of cards that the Examiner has stated is "given patentable weight" is solely determined by the visual representations thereon (e.g., little brother is a wild card). With regard to the point values on the cards, the point values are used to determine the outcome of the card game. The fact that printed matter by itself is not patentable subject matter, because non-statutory, is no reason for ignoring it when the claim is directed to a combination. *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969). Reconsideration is respectfully requested.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation in the reference(s) to modify the reference(s) or to combine reference teachings. However, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. M.P.E.P. § 2143 citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). Second, there must be a reasonable expectation of success. M.P.E.P. § 2143. Finally, the prior art reference (or references when combined) must teach or

suggest all the claim limitations. See, M.P.E.P. § 2143. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. M.P.E.P. § 2143, *citing, In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In this case, as explained above, the elements in the Applicant's claims are not found in the prior art. The third prong, at least, of a prima facie case has not been met because the prior art references when combined do not teach or suggest all the claim limitations.

The courts have consistently held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, incentive, or motivation supporting the combination. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

With regard to the Examiner's statement that the present invention is obvious because it would have been obvious to modify the visual representation in Addabbo's cards, the Applicant respectfully disagrees. The Applicant's claimed invention is not obvious and does not become so because of impermissible hindsight.

For example, it is not apparent how the visual representations of

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robots make visual representations of historical buildings obvious.

New independent claims 26-28 are very similar to claims 1 and 6, except that claims 26-28 are not limited to fifty-two cards in the deck.

Accordingly, Applicant believes that all pending claims are in condition for allowance, and respectfully requests early and favorable allowance.

The Examiner is invited to telephone the undersigned, Applicant's Attorney of record, to facilitate advancement of the present application.

Respectfully submitted,

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